

Patent
U.S. Patent Application No. 09/919,461
Attorney's Docket No. 00-5017

REMARKS

This amendment is responsive to the final Office Action¹ mailed November 18th, 2004. Claims 1-5, 7-32 were presented for examination and were rejected. The independent claims are 1, 8, 17, 24, 28 and 30 and all have been amended. No new matter is added. No claims are canceled. No claims are added. Thus, claims 1-5 and 7-32 are pending. The specification, paragraph [0023] has been amended again to improve grammatical form.

Claims 1-5, 7-12 and 15-32 are rejected under 35 U.S.C. § 102(b) as being anticipated by MORRILL, Jr. (U.S. Patent No. 5,991,749). Claims 13 and 14 are rejected under 35 U.S.C. § 103(a) as unpatentable over MORRILL, Jr. in view of STILP et al. (U.S. Patent No. 5,327,144). These rejections are respectfully traversed for the following reasons.

First, consider Claims 1-5, 7-12 and 15-32 which are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by MORRILL, Jr. The basic purpose of Applicant's invention is set forth in Applicant's specification. Applicant recognized "a need for systems and methods that facilitate order placement and order fulfillment in a manner that avoids delays inherent in waiting for the physical presence of customers to initiate the process of ordering and fulfilling orders" [¶ 005]. In other words, Applicant found a novel solution to the problem of delay inherent in placing orders for goods and services while waiting (possibly in line) at the goods and services provider's (vendor's) establishment. In a novel and unique manner, Applicant places those orders in advance from a remote location prior to arriving at the service provider's establishment, whereby

¹ The Office Action may contain a number of statements characterizing the cited references and/or the claims which Applicant may not expressly identify herein. Regardless of whether or not any such statement is identified herein, Applicants do not automatically subscribe to, or acquiesce in, any such statement.

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those orders can be available and ready for pickup by the customer with minimal or no delay by the time that the customer traverses the remote distance from the location of placement of the order to the location of the vendor's establishment. Thus, the fundamental dynamic of Applicant's invention involves trading-off customer's time of travel from the particular location where the customer's order is placed against inherent time delay that would have occurred, or would have been expected, in fulfilling the order, had the order been placed by the customer, in person, at the vendor's establishment. It is clear from a reading of MORRILL, Jr. that it has absolutely nothing to do with this fundamental dynamic of Applicant's invention.

MORRILL, Jr. describes the use of cellular telephones and other analog or digital wireless communication devices to conduct transactions and activities. These procedures effectively allow such devices to function as an electronic wallet, a wireless PIN pad, and a contact-less Smart Card (Abstract). Although MORRILL, Jr. is an interesting reference that does show use of a cell phone to make payment for goods and services purchased by the operator of the cell phone, it does not connect these purchases and the payment for these purchases to the above-noted time delay problem, the solution of which is presented by Applicant's invention. Nor does MORRILL, Jr. even suggest that connection, for the following reasons.

Applicant's claim 1, for example, recites:

A system configured to facilitate ordering of goods or services from a vendor by a customer, comprising:

one or more base stations configured to receive an abbreviated dialing sequence that corresponds to an order from a mobile terminal used by the customer; and
a processing center coupled between the one or more base stations and the vendor and configured to receive the abbreviated dialing sequence, to transmit customer information to the vendor relating to the order based on a location of the mobile terminal,

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the location being remote from the vendor, and to bill a wireless account of the customer for a monetary amount of the order. (Emphasis added)

Accordingly, Applicant claims a system for ordering goods and services from a vendor remotely located from the customer at the time the order is placed. The Examiner relies on the paragraph in MORRILL, Jr. bridging columns 6 and 7, namely: column 6, line 63 through column 7, line 12, for a discussion of subject matter which allegedly anticipates claim 1 (Office Action pg. 4). But, this section of MORRILL, Jr. as well as anyplace else in the reference falls short of anticipation.

To begin with, the example in MORRILL, Jr. to which this passage relates, describes a parking lot situation, where a customer/driver in an automobile is going to pay for a parking space. It is clear that the described automobile is located AT the parking facility when its customer/driver/cell-phone operator makes payment via its cell phone:

“The relationship agreement will also establish the unique transaction codes to be used by cell phone users (parking customers) as they enter and exit the parking facility”. (column 6, lines 51-54, emphasis added)

Accordingly, as the customer enters or exits the parking facility, the customer uses his/her cell phone to make payment, etc. This close proximity between cell-phone user and vendor location does not suggest remote distance between cell phone user and vendor location. That is, “a processing center ...configured... to transmit customer information to the vendor relating to the order based on a location of the mobile terminal, the location being remote from the vendor...” as recited in claim 1, is not suggested by a customer using its cell phone AT the vendor's

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establishment (parking lot in this instance). In the applied reference, the location of the mobile terminal (cell-phone) is not remote from the vendor. Indeed, the location of the cell-phone is AT the vendor (parking lot), which is completely opposite from the claimed "location being remote from the vendor". In the reference, there is no suggestion of the time delay problem presented in Applicant's disclosure and therefore no suggestion of a solution to that problem, including Applicant's solution of ordering early and offsetting driving or walking time to the service provider's location against the service provider's order-filling time.

A proper rejection under 35 U.S.C. § 102 requires that the reference teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. See M.P.E.P. § 2131. The above recited claim element: "*a processing center coupled between the one or more base stations and the vendor and configured to receive the abbreviated dialing sequence, to transmit customer information to the vendor relating to the order based on a location of the mobile terminal, the location being remote from the vendor, and to bill a wireless account of the customer for a monetary amount of the order*" is not disclosed, suggested or inherently present in MORRILL, Jr., for reasons given above. Therefore, for at least this reason, it is respectfully requested that the 35 U.S.C. § 102(b) rejection of claim 1 be withdrawn and the claim allowed.

Independent claims 8, 17, 24, 28 and 30, also rejected under 35 U.S.C. § 102(b) as being anticipated by MORRILL, Jr., have all been amended to include the same or similar language with respect to the location of the mobile terminal (cell-phone) being remote from the vendor's

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premises. It is therefore submitted that all of these independent claims are likewise allowable for the reasons presented above and that the rejection be withdrawn and the claims allowed.

Secondary reference STILP et al., a cellular telephone location system, does not cure the above-noted deficiency of MORRILL, Jr.

Claims 2-7 are dependent from allowable claim 1, claims 9-16 are dependent from allowable claim 8, claims 18-23 are dependent from allowable claim 17, claims 25-27 are dependent from allowable claim 24, claim 29 is dependent from allowable claim 28 and claim 31 is dependent from allowable claim 30. Accordingly, each of these dependent claims are allowable, at least for reasons based on their respective dependencies from allowable base claims.

The dependent claims are also allowable for reasons based on their respective recitations. Consider, for example, claim 11 which recites "identifying a vendor that is most convenient to the customer based on the determined location of the mobile terminal and sending the customer information to the identified vendor" (emphasis added). These features are not disclosed or suggested in MORRILL, Jr. despite the "inherency" position taken by the Examiner: "It is inherent that the most convenient vendor is the vendor located closest to the mobile terminal" (Office Action, pg. 5). Applicant respectfully disagrees because this is not always true.

For example, consider the scenario where a customer using a cell-phone in an automobile driving on a divided highway, like the Interstate highways, is placing an order in accordance with Applicant's invention with a restaurant, e.g., a McDonald's restaurant, while simultaneously

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driving past a highway interchange where a McDonald's ("FIRST McDonald's") is located off the highway. If another McDonald's ("NEXT McDonald's") is available several miles away at the very next interchange, which is not unusual, then it is the NEXT McDonald's which is the most convenient vendor for this customer, not the FIRST McDonald's which has just been driven past and missed. FIRST McDonald's is no longer conveniently accessible by this customer at this time, driving at highway speeds away from FIRST McDonald's. Although, FIRST McDonald's may be the closest as the crow flies, NEXT McDonald's is the closest to this customer considering the highway constraints placed on this customer. After all, this customer would have to drive to the next upcoming exit (where NEXT McDonald's is located), retrace its path back on the opposite side of the highway, and thus drive twice as far, to get back to the missed interchange where the FIRST McDonald's is located, just for the privilege of eating there. That is NOT convenient, where this example proves that the geometrically closest vendor is not necessarily the most convenient vendor under all conditions. Applicant's "determined location of the mobile terminal", as recited in claim 11, would take this constraint into account. Thus, MORRILL Jr., does not inherently disclose Applicant's claim 11 because merely being physically close, e.g., a customer in a car AT a parking lot location, does not necessarily suggest the most convenient vendor based on the recited "determined location", for reasons given above. For at least this additional reason claim 11 is not anticipated by MORRILL Jr.

The amendments to the claims are supported by the specification and claims as filed. No new matter is added. See, for example, Applicant's specification and claims, at least paragraph

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[0018], line 6; paragraph [0021], line 2; paragraph [0044], line 8; claim 24, line 4.

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CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests the Examiner's reconsideration of this application, and the timely allowance of the pending claims. This amendment including the remarks, interalia, directly addresses points raised in the "Response to Arguments" section of the Office Action, to demonstrate the need for withdrawal of the rejection; accordingly, this amendment should be entered since no new searching is necessary and no new issues have been raised. Moreover, even if the Examiner does not find the instant amendment persuasive, by entering the amendment the issues to be presented on appeal shall be narrowed down.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2347 and please credit any excess fees to such deposit account.

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